

The examiner asserted that the claims of the present application lack unity of invention under PCT Rules 13.1 and 13.2 because the species lack the same or corresponding special technical features. More specifically, the examiner alleged that the compounds of claim 1 do not possess a single inventive structural element that is shared by all of the alternatives.

Annex B, Part 1 (f) of Administrative Instructions under the PCT provides that in the case of Markush grouping, alternatives shall be regarded as being of a similar nature, *i.e.*, to meet the "special technical features" requirement under PCT Rule 13.2, where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, *i.e.*, a significant structural element is shared by all of the alternatives.

The words "significant structural element is shared by all of the alternatives" are further explained to refer to cases where the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art when the compounds have in common only a small portion of their structures. *See* Annex B, part I, (f)(ii).

In the present case, the compounds embraced by formula in claim 1 have been shown to possess the property or activity of modifying histamine H<sub>3</sub> receptors. More specifically, test results on pages 87-92 of the application demonstrate that the tested compounds sufficiently representing the claimed compounds function as ligands of histamine H<sub>3</sub> receptors. This clearly evidences that the alternatives in the Markush group share a common property/activity.

Furthermore, the compounds of claim 1 share the "significant structural element" of a "saturated heterocyclic ring" substituted with C2 to C10 alkylene in their chemical structure. As recognized in the International Preliminary Examination Report, the claimed compounds are found to be novel and inventive from histamine H<sub>3</sub> receptors known in the prior art because of a saturated heterocycle ring in their

chemical structures. Thus, the commonly shared structure in the claimed compounds constitutes a structurally distinctive portion in view of existing prior art.

Therefore, the Markush grouping of the present application has met the criteria for alternatives of chemical compounds having a similar nature. Accordingly, because unity of invention exists for the present application, Applicants respectfully request reconsider of the requirement of election of species.

Applicants earnestly await receipt of the initial Office Action on the merits.

If there are any fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date

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By

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